UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,485	03/01/2004	David N. Still	50325-0879	1876

29989 7590 07/14/2006

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER	
CAO, DIEM K	

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,485	STILL ET AL.	
	Examiner	Art Unit	
	Diem K. Cao	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/26/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-34 are presented for examination.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/225,909, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claims 11, 22 and 33 recite limitation "wherein the first server and the second server form part of a load-balanced server group, and wherein both the first server and the second server are capable of responding to the client request", which is not supported by the prior-filed application. Accordingly, claims 11, 22 and 33 are not entitled to the benefit of the prior application.

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to change the relationship (continuation or divisional application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: the first server and the second server form part of a load-balanced server group, and wherein both the first server and the second server are capable of responding to the client request.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the computer readable medium is define as a "***wave***" (specification, paragraph 66) (such as a carrier wave). In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10, 12-21, and 23-32 are rejected on the ground of nonstatutory double patenting over claims 1-10, 12-21 and 23 of U. S. Patent No. 6,718,390 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a method of redirecting a request from a client that may be served by a first server to a second server, comprising steps of receiving a client request at the second server, automatically forwarding the client request to the first server, receiving a result message from the first server, identifying in the result message, references to resources of the first server, replacing the references to resource of the first server with translated references that reference the second server, and sending the translated references to the client as a response to the request.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 12-19, 23-30, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Sidana (U.S. 6,081,829).

As to claim 1, Sidana teaches (col. 4, lines 31-33; col. 5, line 44 - col. 6, line 67; and col. 7, lines 62-67) a request (URL of the document to view; col. 6, lines1-10), client (computer 110, browser 170; col. 4, lines 31-33), first server (server 174; col. 6, lines 29-31), second server (machine120, redirector 172; col.5, lines 46-48), result message (HTML document; col.6, lines 31-32), resource references (URL of the target document; col. 6, lines 36-39), translated references (URL of the redirector; col.6, lines 36-44), and send result message to client (redirector 172 sends HTML to browser 170; col.6, lines 44- 48).

As to claim 2, Sidana teaches (col. 10, lines 64-67 to col. 11, lines 1-3) a second request (a display element; col. 10, lines 64-65), the response (the augmented HTML; col. 10, lines 64-66), the second server (redirector; col. 10, lines 66-67 to col.11, line 1), repeating steps as mention in claim 1 (the redirector generates augmented HTML; col.11, lines 1-3).

As to claim 3, Sidana teaches (col. 6, lines 49-57; col. 7, lines 62-67) parsing the result message (redirector parses the HTML; col. 6, lines 51-53) to identify tags ("http" strings; col. 6, lines 53-54), and attributes identify resources ("machine3.company3.com"; col. 7, line 62-67).

As to claims 4 and 5, Sidana teaches a value (port:8080; col. 7, lines 47-50) identifies a process (Redirector 172 ... listens on a specified port for browser requests; col. 5, lines 35-40).

As to claim 6, Sidana teaches (col. 5, lines 34-35; col. 6, lines 29-48) an HTTP request (browser sends an HTTP request; col.5, lines 34-35), a second Web server (Redirector sends augmented HTML; col. 6, line45-47), a first Web server (server 174 returns HTML for the requested document to redirector 172; col. 6, lines31-32), an HTTP response message contains HTML document (an HTML; col. 6, lines 31-32).

As to claim 7, Sidana teaches parsing the HTML document to identify one or more URLs (HTML of the requested document may contain URL ... looking for such URLs; col. 6, line 49-53).

As to claim 8, Sidana teaches parsing the HTML to find URLs reference to the first web server and URLs do not (URLs link to the URL: http://machine3.company3.com; col. 7, lines 62-67) (looking for URLs that links to other documents in the WWW; col. 6, lines 49-54).

As to claims 12 and 23, they are the same as the method in claim 1 except they are apparatus and product claims, respectively.

As to claims 13-19, see rejections of claims 2-8 above.

As to claims 24-30, see rejections of claims 2-8 above.

As to claim 34, see rejections of claims 1-8 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 9, 20, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana in view of Dykes et al.(U.S. 5,872,915).

As to claims 9, 20 and 31, Sidana does not use CGI script. Dykes teaches to use of CGI script to service requests (see col.13, lines 5-25). It would have been obvious to use the CGI

script as taught by Dykes et al. in the system of Sidana because CGI programs provide performing desired functions such as passing data from one server to another server, or parsing HTML document.

As to claim 34, see rejection of claim 9, 20 or 31 above.

9. Claims 10, 21, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana.

As to claims 10, 21 and 32, Sidana teaches parsing an HTML document to find URLs (http://machine3.company3.com) and replacing those URLs with its URL. However, Sidana does not teach to store in an output message tags that are not match with the resource references. It would have been obvious that parsing and stream tokenizing carry out the same function, in this case is identifying tags, and for tags that are not candidate for replacing, Sidana's system could present unmodified links to users.

As to claim 34, see rejection of claim 10, 21 or 32 above.

10. Claims 11, 22 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana in view of Ahuja et al (U.S. 6,175,869 B1).

As to claims 11, 22 and 33, Sidana does not teach wherein the first server and the second server form part of a load-balanced server group, and wherein both the first server and the second server are capable of responding to the client request. However, Ahuja teaches the first

server and the second server form part of a load-balanced server group, and wherein both the first server and the second server are capable of responding to the client request (See fig. 4 and associated text). It would have been obvious to apply the teaching of Ahuja to the system of Sidana because it provides load balancing on the server, and an optimal distribution of request load across the servers of a server pool (col. 2, lines 9-13).

As to claim 34, see rejection of claim 11, 22 or 33 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diem K. Cao whose telephone number is (571) 272-3760. The examiner can normally be reached on Monday - Friday, 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Diem Cao

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER